

IN PROCESS REVIEW**Application****Number**

09/770,379

Art Unit

2625

Rejection**Mail Date**

25-Nov-03

Examiner

CHOOBIN, MAHMOOD B

Rejections Made

The office action contains rejections made under the following statutes:

- ☐ 35 U.S.C. 102
- ☒ 35 U.S.C. 103
- ☐ 35 U.S.C. 112, first paragraph, written description
- ☐ 35 U.S.C. 112, first paragraph, enablement
- ☒ 35 U.S.C. 112, second paragraph
- ☐ 35 U.S.C. 101 (utility)
- ☐ 35 U.S.C. 101 (non-statutory subject matter)
- ☐ Double Patenting (statutory, ODP)
- ☐ Other (e.g., Best Mode)

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Omitted Rejections

Is there a potential clear error for omitting a rejection? (The rejection you propose must be reasonable)

☐ Yes ☒ No

If yes, check all that apply

- ☐ 35 U.S.C. 102
- ☐ 35 U.S.C. 103
- ☐ 35 U.S.C. 112, first paragraph, written description
- ☐ 35 U.S.C. 112, first paragraph, enablement
- ☐ 35 U.S.C. 112, second paragraph
- ☐ 35 U.S.C. 101 (utility)
- ☐ 35 U.S.C. 101 (non-statutory subject matter)
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Section III. 35 U.S.C. 103**Correctness of 35 U.S.C 103 Rejections**

Were all 35 U.S.C 103 rejections reasonable?

☒ Yes ☐ No**(No indicates the presence of a potential clear error)**

If no, indicate the problem (check all that apply)

- ☐ Claimed features not found in the reference.
- ☐ References not combinable.
- ☐ Date of the reference no good.
- ☐ Improper motivation.
- ☐ No reasonable expectation of success.
- ☐ Improper Official Notice taken.
- ☐ Other

Comments:

Clarity of 35 U.S.C 103 Rejections

Were all 35 U.S.C. 103 rejections formulated in a clear manner?

☐ Yes ☒ No**(No indicates potential clear error)**

Were claim limitations matched to the art?

☐ Yes ☒ Sometimes ☐ No

Were the differences clearly stated?

☒ Yes ☐ Sometimes ☐ No

Was the modification or combination of references clearly explained

☐ Yes ☒ Sometimes ☐ No

Was the motivation/reasons for obviousness present?

☐ Yes ☒ Sometimes ☐ No

Comments:

It is not clear whether the examiner is proposing a rejection for claim 1 under 35 U.S.C 103 alone or if the examiner is proposing a rejection for claim 1 under 35 U.S.C. 02 or 103 (Form Paragraph 7.27).
The proposed modification of claim 1 lacks motivation.

35 U.S.C 103 Rejection(s) That Should Have Been Made

Give a brief description of the 35 U.S.C. 103 rejection(s) that should have been made:

Origin of Prior Art used in the proposed 35 U.S.C. 103 rejection(s) above

☐ of record☐ not of record (attach search logic/documentation)☐ East☐ EPO☐ Other☐ West☐ JPO☐ NPL☐ Derwent

Comments:

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Section VII. 35 U.S.C. 112 2nd paragraph

Correctness of 35 U.S.C 112 2nd Paragraph Rejections

Were all 35 U.S.C 112 2nd paragraph rejections reasonable?

☒ Yes ☐ No

(No indicates potential clear error)

Comments:

Clarity of 35 U.S.C 112 2nd Paragraph Rejections

Were all 35 U.S.C 112 2nd paragraph rejections formulated in

☒ Yes ☐ No

Comments:

35 U.S.C 112 2nd Paragraph Rejection(s) That Should Have Been Made

Give a brief description of the 112 2nd paragraph rejections that should have been made:

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SECTION XI. File Wrapper**Reasons for Allowance (R/A)**

Did the Examiner write a Reasons for Allowance (R/A)?

☐ Yes ☒ No ☐ N/A

If yes,

Is the R/A clear and complete?

☐ Yes ☐ No

If no,

Does the record as a whole indicate a R/A was necessary?

☐ Yes ☒ No

Comments:

Interviews

Was there an interview regarding the merits of the case relevant to the action reviewed?

☐ Yes ☒ No

If yes,

Was Summary Form PTOL-413 completed?

☐ Yes ☐ No

Is the record of the interview clear and complete?

☐ Yes ☐ No

Comments:

Claims

Were claims treated in an inappropriate manner on non-substantive issues?

☐ Yes ☒ No

If yes,

☐ claims are present that were not addressed.☐ claims previously withdrawn from consideration should have been cancelled.☐ improper dependent claims were not properly treated.☐ other

Comments:

Sequence Rules

Does the application contain nucleotide and/or amino acid sequences?

☐ Yes ☒ No

If yes,

Did the examiner properly handle Sequence Compliance Issues?

☐ Yes ☐ No

Comments:

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Section XIII. Other Issues

Were all claims for priority properly treated?

☒ Yes ☐ No ☐ N/A

If a restriction was made, was it proper?

☐ Yes ☐ No ☒ N/A

Were all matters of substance in applicant's response and affidavits/declarations evaluated sufficiently?

☐ Yes ☐ No ☒ N/A

Other issues?

☐ Yes ☒ No

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Comments:

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Section XIV. Indicia of Commendable/Outstanding

Patentability Determination: Indicia of Commendable/Outstanding

The record developed by the examiner shows an indication of allowable subject matter at the earliest time which is consistent with the file record and prosecution of the application. ☐ Yes

Through the rejections and arguments made by the examiner, an appropriate line of patentability is established which results in amendment(s) properly limiting the scope of an ☐ Yes

The search record in the application clearly shows that the examiner construes the claimed subject matter in its broadest reasonable interpretation and seeks to develop prior art from the appropriate peripherally related art areas. ☐ Yes

Action Taking: Indicia of Commendable/Outstanding	
<p>1. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>2. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>3. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>4. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>5. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>6. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>7. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>8. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>9. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>10. Proactive – Anticipates and identifies potential problems before they become serious.</p>	<p>1. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>2. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>3. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>4. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>5. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>6. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>7. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>8. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>9. Proactive – Anticipates and identifies potential problems before they become serious.</p> <p>10. Proactive – Anticipates and identifies potential problems before they become serious.</p>

The statements of rejection, objection, and response to arguments clearly and concisely present the positions taken or recommended in the resulting Office actions including a thorough substantive explanation to convey those positions to the applicant. ☐ Yes

The Office action usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. ☒ Yes

The Office action indicates that the principle of compact prosecution is being fully followed. Note, the principle of compact prosecution comprises conducting an initial search which is as complete as possible including consultation with an expert in the art where the examiner lacks such expertise (see search guidelines); placing art of record which meets both the concept and the wording of the claims as well as other art which is pertinent to significant though unclaimed features of the disclosed invention; and issuing a first Office action which clearly explains the examiner's position on each essential issue in such detail that absent some unexpected consideration the next Office action may be made final.

☐ Yes

Patent Examining Function: Indicia of Commendable/Outstanding

Check one of the following statement if applicable:

- ☐ The Office action is formulated to advance the prosecution, correct other informalities, and develop a complete file wrapper record. The Office action also is such that it leaves little room for improvement. The Office action clearly and concisely presents the positions taken.
- ☐ The entire Office action is complete and accurate and does not require any substantial revision. The Office action effectively conveys the positions taken.

Comments:

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Section XII. "X" Actions

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Search**Initial Data Capture Points**

- Was art provided from an ESS before first action? ☐ Yes ☐ No
- Was any IDS improperly treated? ☐ Yes ☐ No ☒ N/A
- Was a text search performed by the Examiner? ☒ Yes ☐ No
- Was it non-patent literature? ☒ Yes ☐ No
- Is the search strategy printout present? ☒ Yes ☐ No ☐ N/A
- Was the inventorship searched by the Examiner? ☐ Yes ☒ No
- If any TC or specialized art has identified specific search requirements in addition to or in exclusion of the above requirements, were these specific requirements complied with? ☐ Yes ☐ No ☒ N/A
- Were foreign patent documents cited by the Examiner on an 892? ☐ Yes ☒ No
- Were NPL documents cited by the Examiner on an 892? ☐ Yes ☒ No
- Did the Examiner perform a new search in a 2nd/subsequent action? ☐ Yes ☐ No ☒ N/A
- Did the Examiner update all searches in a subsequent action? ☐ Yes ☐ No ☒ N/A
- Did an ESS submit a new search report in a 2nd/subsequent action? ☐ Yes ☐ No ☐ N/A
- Was there new art found by the Examiner that was applied in a 2nd/subsequent action? ☐ Yes ☐ No ☒ N/A
- Has a search been performed by the Reviewer? ☐ Yes ☒ No

Overall Rating of the Search

- ☒ Adequate
- ☐ Less than Adequate

Comments: